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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,188

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Roger Sarver

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03/21/2006

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EXAMINER

ADAMS, GREGORY W

ART UNIT

PAPER NUMBER

3652

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/727,188	SARVER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gregory W. Adams	3652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1-3, 5-7, 8-10, 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by White et al. (US 3,915,317) (previously cited). It is noted that although White handles dental packets, a recitation of the intended use of the claimed invention, e.g. to handle wafers, must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With respect to claims 1-3, White discloses housing 22, member 40, housing supports 42 wherein housing supports are flexible.

With respect to claims 5-7 & 21-22, White discloses a transfer arm 40, basket 28 and basket lift 26.

With respect to claims 8-10, White discloses a housing 22, housing supports 42 and a basket 28, basket lift 26.

With respect to claim 20, White discloses a side opening. FIG. 7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US 3,915,317) in view of Hardy (US 2,407,782) (previously cited).

With respect to claim 4 & 11, 18, White does not disclose pivotal housing supports. Hardy discloses pivotal housing supports 13 such that during stacking such that prior to placement on a stack, an individual unit is held horizontal whereupon placement upon a stack housing support pivot by engaging a stack yielding an even stack. Col. 1; col. 4. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modify White to include pivoting supports, as per the teachings of Hardy, to produce an even stack.

With respect to claim 12, White discloses a transfer arm 40, basket 28 and basket lift 26.

3. Claims 13-15 & 19 rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US 3,915,317) in view Nichols (US 5,735,662). White discloses transporting articles via any suitable transport mechanism, and does not disclose pushing wafers to transfer from a cassette to a housing. Nichols discloses a transferring further comprising pushing wafers from a wafer cassette to a housing through a transfer guide. Nichols teaches that mass production requires transfer from a cassette which supports processed wafers to a housing for further process steps such as

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transportation. Cols. 1-2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the transport mechanism of White to include pushing wafers from a cassette to a housing, as per the teachings of Nichols, such that the wafers are ready for further transportation.

4. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. (US 3,977,566) in view of De Luna, Jr. et al. (US 2002/0098067).

With respect to claim 16, Hill et al. disclose:

positioning wafers proximate to a housing (indicated generally as 11) wherein a housing has top and bottom openings and supports 15;

transferring wafers into a housing through a transfer guide 21; and

releasing wafers from flexible (or pivotable) supports to collect into a stack.

Hill et al. do not disclose stacking or pushing. However, Hill et al. disclose a dispensing adaptor 12, i.e. basket, which could be used to collect a stack because FIG. 8 discloses a basket with capacity beyond that of a single wafer 20. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Hill et al. to include stack wafers because Hill's basket capacity does not preclude more than one wafer.

Hill et al. disclose gravity transfer but does not disclose pushing wafers. De Luna, Jr. et al. disclose a pushing wafers through a transfer guide onto housing supports 13 as is well known in the art of wafer fabrication lines. Para. [0006]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hill's transferring wafers from a position proximate to a housing into a

housing by pushing, as per the teachings of De Luna Jr. et al., as is well known transfer method within the art of wafer fabrication.

### ***Response to Arguments***

Applicant's arguments filed February 6, 2006 have been fully considered but they are not persuasive. Amended claim 16 has been addressed on the merits above addressing the added structure of top, bottom and side openings as well as the step of pushing.

With respect to claims 1-3 & 6-10, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, White's housing, transfer guide and member are certainly capable of releasably maintaining wafers, facilitating transfer, and collecting wafers into a stack, and without structure to define a "housing", White's chute 22 is a housing in that it would support the wafers. Further, with respect to chutes v. baskets, although White's chute works opposite to the Applicant's invention, claim 1 does not define the direction in which the elements are dispensed.

With respect to claim 4, White et al. disclose a transfer arm 40 (C3/L15-16), and the attachment of Hardy's supports is irrelevant because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hardy teaches pivotable supports that maintain an article in a horizontal position prior to placement on a stack. C1/L20-22. The use of supports for dental packets or trays or even wafers is immaterial unless Applicant recites structure that defines its supports over the cited prior art. Moreover, Applicant is respectfully reminded that the material or article worked upon by the apparatus does not limit apparatus claims. See MPEP 2115.

With respect to claims 8, 11-12 & 13, a basket is at least defined as "a receptacle made of interwoven material" ([www.m-w.com](http://www.m-w.com)). As noted above, Applicant recites a basket "configured to receive wafers" which White certainly is by including at least a horizontal bottom upon which a stack could be placed.

With respect to claim 5, White at least discloses transfer arms 40 that both guide and stack because said arms "extend from a common post 46 which is reciprocally movable by any suitable mechanism, not shown, between an upper position and a lower position." C3/L30-35. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant recites configuring structure to perform a particular function without disclosing structure that defines over the prior art. In this case claim 5 merely requires a function which is disclosed by White.

With respect to claim 8, at least discloses both the ability to guide and stack because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant recites configuring structure to perform a particular function without disclosing structure that defines over the prior art. In this case Whites' basket 28 claim 8 merely requires function which is performed by White can perform by transferring a stack from a chute onto a platform 28. C2/L64-68. Thus, White discloses the functionality of receiving and disengaging wafers and manipulating said wafers into a stack.

With respect to claims 13-15, Applicant also argues that White et al. does not disclose a transfer guide. With respect to FIG. 1, White discloses a die opening 16 through which a dental packet is intermittently transported by any suitable transport mechanism. C2/L47-50. White's opening certainly can guide dental packets into a basket.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W. Adams whose telephone number is (571) 272-8101. The examiner can normally be reached on M-Th., 8:00-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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